

Remarks/Arguments

The Office Action of 14 March 2005 has been carefully reviewed and this response addresses the Examiner's concerns stated in the Office Action. All rejections are respectfully traversed.

Claim Rejections - 35 USC § 103

On pages 2-13, paragraphs 2-27 of the Office Action, claims 1, 3-11 and 13-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Weinberg et al., U.S. Patent 6,360,332, (Weinberg) in view of Gerace, Thomas A., U.S. Patent 5,848,396 (Gerace). Please note that claim 1 is the base claim for claims 3-10 and claim 11 is the base claim for claims 13-20.

Paragraph 3 of the Action indicates that the Examiner believes Applicants are mistaken in their assertion that the present application can claim priority to provisional patent application 60/200295. Applicants respectfully supply three pages (as Exhibit A) of the prosecution history of the present application, downloaded from the USPTO's "Patent Application Information Retrieval" system, that clearly show that Applicants filed a preliminary amendment adding a priority claim to the provisional application into the present application's specification. The amendment incorporating the priority claim into the specification is stamped received by the USPTO's OIPE on 25 April 2001, within four months of the filing date (30 March 2001) of the present application and within 16 months of the filing date (28 April 2000) of the provisional application, either of which would satisfy the requirements of M.P.E.P. §201.11. Applicants point out that the Weinberg reference relied upon primarily in the rejections issued on 19 March 2002, after the filing date of the present application and well after the filing date of the Applicants' provisional application. Applicants, thus, respectfully reserve the right to file a petition under 37 C.F.R. § 1.131 to swear behind the Weinberg reference.

To each of base (independent) claims 1 and 11 has been added a limitation related to a *proxy*-based recording system, which appears to distinguish the presently claimed invention from the screen-scraping implementation of Weinberg. The record and playback mechanisms of the invention, via an HTTP proxy, allows ease-of-use and remote configuration ability. The transaction is recorded by the proxy and played back by the HTTP transaction test when the actual test is performed. A set of web-based transaction editing frames is used to create

and edit a transaction. Weinberg's recorder module appears to function by capturing screens into window 206. As neither Weinberg nor Gerace appear to teach a proxy-based implementation, Applicants respectfully submit independent claims 1 and 11, and claims 3-10 and 12-20 through dependency, are patentable over the cited art.

Applicants also respectfully reassert that that Weinberg discloses (see col. 8, line 46 through col. 9, line 24) a testing tool including a user interface through which a user interacts with a transactional server. Weinberg teaches that the front end of the testing tool is preferably a commercially available client component, such as a browser, but that the front end/user interface is an integral part of the testing tool (see col. 20, line 58 through col. 21, line 37.) The web browser of the presently claimed invention plays a distinct role from the front end/user interface taught by Weinberg. Whereas in Weinberg the user interface is incorporated into the testing tool, in the presently claimed the web browser may be any remote browser not functionally integrated with the *processor* responsible for the operation of the web browser, other than to receive and transfer information to the web browser. The testing tool of Weinberg is more akin to the client software as discussed in Applicants' specification (see paragraph [0006]), wherein a complex application is loaded upon the same machine upon which the web browser operates. As discussed, such testing tools/applications require at a minimum cookies or Java applets to be stored on the user's machine. Weinberg's testing tool appears to require the entire test application be stored on the user's machine, unlike the presently claimed invention, which allows the user to access the processor remotely with no interference or local storage requirement on the user's machine. Rather, the processor of the presently claimed invention enables any web browser to record, edit and play back a transaction through communications with the processor (see Figure 11 of the instant specification), and the processor serves to generate and transfer Hypertext Markup Language (HTML) pages without cookies to the web browser (emphasis added.)

Applicants additionally note that Weinberg and Gerace do not appear to teach or suggest the ability to edit automated test scripts through the web browser. Weinberg's testing tool uses a commercially available web browser only to record a transaction, and thereafter employs a user interface to present alternative tree or spiral structures for clicking and dragging icons about the screen to perform editing of a captured session. In contrast, the presently claimed invention allows a user to employ his/her web browser (again,

operationally distinct from the processor implementing the present invention) to facilitate editing of a transaction session to create test cases.

Applicants respectfully point out that, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Further, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. Since Weinberg and Gerace, separately or in combination, do not teach or suggest each and every element of Applicants' claim 1, either expressly or inherently, Applicants' claims 1 and 11 (as well as claims 3-10 and 13-20 that, respectively, depend therefrom and that further define the invention) are not made obvious by Weinberg and Gerace, and a rejection under 35 U.S.C. § 103 is inappropriate. Applicants respectfully assert that claims 1, 2-11 and 13-20 are now in condition for allowance. Applicants respectfully request the withdrawal of rejections under 35 U.S.C. § 103(a) with regards to such claims for the reasons set forth above.

Conclusion

In view of the absence from any cited reference of Applicants' claimed invention as set forth above, Applicants respectfully urge that Weinberg and Gerace, separately or in combination, are not sufficient to render the presently claimed invention obvious under 35 U.S.C. § 103. Claims 1, 2-11 and 13-20 are believed to be in condition for allowance. All dependent claims are believed to depend upon allowable independent claims, and are therefore also in condition for allowance. Applicants note that the instant Action asserts that prior amendments do not entirely convey the merits of the present invention argued herein, and thus do not overcome the teachings of Weinberg. Applicants respectfully request a

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telephone interview with the Examiner to discuss the merits of the present invention as claimed, with an invitation to contact the undersigned at a time convenient to the Examiner.

The Commissioner for Patents is authorized to charge additional fees or credit overpayment to Deposit Account No. 50-1078.

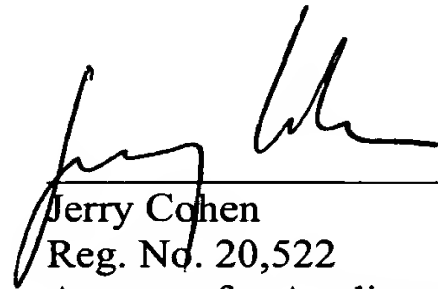
The following information is presented in the event that a call may be deemed desirable by the Examiner:

JACOB N. ERLICH (617) 854-4000

Respectfully submitted,
Mark D. Smith et al., Applicants

Date: June 14, 2005

By:



Jerry Cohen
Reg. No. 20,522
Attorney for Applicants

APPENDIX A